

REMARKS

With the foregoing amendment, claims 1-18 remain pending in the application, with claims 1 and 10 being in independent form. By this amendment, claims 1, 3, 4, 7, 10-12, and 15-17 are amended, and claims 19 and 20 are cancelled without prejudice.

Support for the amendments to claims 1, 3, 4, 7, 10-12, and 15-17 can be found in the originally filed application at, for example, page 5, lines 19-22; page 7, lines 4-10; and page 11, lines 5-10. No new matter would be added upon entry of this amendment.

Based on the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding rejections, and that they be withdrawn.

Examiner Interview

Applicant, Jeremy Rosenberg, and Applicant's representatives, Martin M. Zoltick and Brian S. Rosenbloom, wish to thank Examiner Chang and her Supervisor for extending the courtesy of the in office interview held on June 6, 2003, and for the helpful and courteous discussions. Applicant's representatives believe that prosecution of the present application was materially advanced based on the discussion of the pending claims, the Examiner's rejections set forth in the Office Action mailed March 28, 2003, and the prior art, as summarized in the June 6, 2003 Examiner Interview Summary. In accordance with the agreement reached during the interview, as summarized in the Continuation Sheet attached to the Examiner Interview Summary, Applicant has amended the claims. Accordingly, Applicant respectfully requests that the examiner withdraw all outstanding rejections.

Request for Withdrawal of Finality of Rejection

Applicant respectfully requests the withdrawal of the finality of the March 28, 2003 Office Action. The basis for Applicant's request is that the Office Action adds a new ground of rejection to unamended claims. *See* M.P.E.P. § 706.07(a). Specifically, in the March 28, 2003 Office Action, the rejection of unamended claims 1-14 under 35 U.S.C. §

103(a) included a new reference -- U.S. Patent No. 6,233,692 issued to Fritsch. The new ground of rejection was not necessitated by Applicant's amendment of the claims nor based on information submitted in an information disclosure statement. In view of the foregoing, Applicant respectfully requests the withdrawal of the finality of the rejections of the March 28, 2003 Office Action.

**First Rejection Under 35 U.S.C. § 103(a) (Daly/Schlasberg/Fritsch)**

Independent claims 1 and 10, and claims 2-8, 11-16 and 18 depending therefrom, are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,878,141 issued to Daly ("Daly") in view of Schlasberg PCT No. WO 99/17320 ("Schlasberg") in further view of U.S. Patent No. 6,233,692 issued to Fritsch ("Fritsch"). Applicant respectfully traverses this rejection.

Applicant respectfully submits that independent claims 1 and 10 are not unpatentable over Daly in view of Schlasberg in further view of Fritsch because neither Daly, nor Schlasberg, nor Fritsch, considered alone or in combination, teach or suggest all of the features of claims 1 and 10, as amended. For example, at the least, neither Daly, nor Schlasberg, nor Fritsch disclose the following:

A method ... comprising the steps of:  
 receiving at each remote device a message broadcast from the fulfillment system **without consumer interaction**, the message identifying an item available for delivery in electronic form **by consumer interaction with the broadcast message, wherein the broadcast message is transmitted from a fulfillment system to the remote devices using a first transmission medium**;

...  
 receiving at a particular one of the remote devices associated with one of the consumers an instruction **generated by the consumer's interaction with the broadcast message**, wherein the instruction indicates the consumer's request to obtain the item available for delivery in electronic form;

...; and

delivering, by the fulfillment system to a device associated with the consumer associated with the particular remote device at which the instruction was received, the item requested for purchase by the

consumer using a second transmission medium to deliver the requested item electronically, wherein the second transmission medium is different from the first transmission medium used for the broadcast message.

as is recited in amended claim 1. [Emphasis added.] Independent claim 10, which is directed to a fulfillment system, also recites the emphasized features of the method of claim 1.

Daly discloses a computerized purchasing system and method that provides for the purchase of goods and services through the use of different types of electronic devices, such as a point-of-purchase register, a personal computer, a telephone, a stand-alone machine (e.g., ATM), a television and set-top box unit, and a magnetic-stripe credit card reader (Col. 6, lines 39-44). In one preferred implementation, Daly describes:

an interactive television system is equipped with the purchasing system of Daly to facilitate electronic purchases. The interactive television system includes a head end server, plural set-top boxes, and a distribution network interconnecting the head end server and set-top boxes. The set-top boxes are configured to operate in a program mode, where the corresponding television displays selected television programs, and in a sales mode where the corresponding television displays a user interface which facilitates the purchases of goods and/or services. Each set-top box has an input mechanism (such as a keypad or a remote control device) that permits a requesting subscriber to enter a purchase request to buy goods and/or services from a designated merchant. The purchase request is sent to the head end server where the purchaser and merchant databases are located. As above, a common set of available payment methods are derived and provided to the subscriber on his/her television for selection. The subscriber uses the input mechanism for the set-top box to choose the desired payment method (col. 4, line 60 to col. 5, line 12). [Emphasis added.]

\* \* \*

More particularly, the set-top box can be operated in a sales mode where the corresponding television displays the purchase mediator UI to facilitate purchases of goods and/or services from various merchants. The subscriber employs the UI and an input mechanism, such as the remote control handset, to enter a purchase request for a particular good and/or service from a designated merchant. The purchase mediator helps determine a mutually agreeable payment method that is both accepted by the designated merchant and one of the requesting subscriber's personal payment methods, and then presents

these options to the subscriber. (col. 11, lines 10-22). [Emphasis added.]

\* \* \*

The subscriber manipulates a focus frame in UI 100 using an input device, such as the remote control handset, to select a certain product for purchase from a designated merchant (col. 11, lines 63-65). [Emphasis added.]

As acknowledged by the Examiner, Daly fails to disclose delivering a purchased item in electronic form and, further, using a transmission medium to deliver a purchased item in electronic form that is different from the transmission medium over which the fulfillment system transmitted the message identifying the purchased item.

Applicant submits that neither Schlasberg nor Fritsch make up for the deficient teaching of Daly. Consequently, even if the references are combinable (which Applicant respectfully submits they are not), the combination fails to teach or suggest all of the claimed features.

Schlasberg does not make up for the deficient teaching of Daly because, *inter alia*, nowhere does Schlasberg disclose a “broadcast message” that is transmitted over a first transmission medium. Consequently, Schlasberg cannot, by definition, teach or suggest delivering a purchased item electronically using a second transmission medium, wherein the second transmission medium is different than the first transmission medium, because Schlasberg does not even suggest the existence of a first transmission medium for transmitting a broadcast message. The same holds true for Fritsch.

Furthermore, the systems and methods of the Daly, Schlasberg, and Fritsch references are fundamentally different than the claimed system and method in that the systems and methods of the Daly, Schlasberg, and Fritsch references require, without question, consumer interaction to identify items available for purchase and delivery.

Still further, the systems and methods of the Daly, Schlasberg, and Fritsch references fail to disclose or even to suggest a message broadcast from a fulfillment system without consumer interaction identifying an item available for delivery in electronic form by consumer interaction with the broadcast message, as recited in amended claims 1 and 10.

Separate and apart from the above-noted deficiencies in the teachings of Daly, Schlasberg, and Fritsch, which each alone obviate the Examiner's rejection of claims 1 and 10, Applicant submits that there is simply no evidence of any teaching, suggestion, or motivation supporting the combination of the teachings of the Daly, Schlasberg, and Fritsch references to achieve the claimed invention. The fact that, in the system described in Daly, users can select their method of payment from a plurality of stored options, would not have taught or suggested to, or motivated, a person skilled in the art to modify the system of Daly to provide for electronic delivery of the goods or services purchased "using a second transmission medium to deliver the requested item electronically, wherein the second transmission medium is different from the first transmission medium used for the broadcast message." As is apparent from the above-referenced portions of Daly, Daly does not even deal with items available for purchase in electronic form. Moreover, even if it did, since there is no "broadcast message," it is not seen how Daly, or for that matter Schlasberg or Fritsch, could teach, suggest, or provide any incentive to modify the system of Daly to use a transmission medium to deliver the item in electronic form different from the transmission medium used to transmit the broadcast message.

For the forgoing reasons, Applicant respectfully requests that the rejection of claims 1 and 10, and the rejection of claims 2-8, 11-16 and 18 depending therefrom, be withdrawn.

**Second Rejection Under 35 U.S.C. § 103(a) (Daly/Schlasberg/Fritsch/Set-Top Box)**

Claims 9 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Daly in view of Schlasberg in further view of Fritsch, in further view of "Set-top box for television that reads your mind" ("Set-Top Box"). Applicant respectfully traverses this rejection.

Applicant submits that claims 9 and 17, which depend either directly or indirectly from claims 1 and 10, are not unpatentable over Daly in view of Schlasberg in further view of Fritsch, in further view of Set-Top Box, considered alone or in combination, for at least

the same reasons as discussed above in connection with claims 1 and 10.

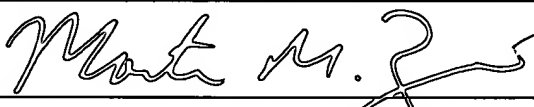
For the forgoing reasons, Applicant respectfully requests that the rejection of claims 9 and 17 be withdrawn.

### CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections, and that they be withdrawn.

Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Favorable consideration of this application is respectfully requested.

| RESPECTFULLY SUBMITTED,    |   |           |              |             |              |
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